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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/918,497 | 08/01/2001 | Shinya Hondo | Q65530 | 3221 |

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

CORRIELUS, JEAN B

ART UNIT PAPER NUMBER

2611

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 09/918,497 | Applicant(s) HONDO, SHINYA | |
| | Examiner Jean B. Corrielus | Art Unit 2611 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. In view of the amendment to the claims , filed on 7/3/06, the 112 rejection of claims 6 and 14 has been withdrawn and rejection under 112 first paragraph is set forth below.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 6 and 14 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A respective memory connected between a **pair of rake combiners** and the decoder critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The specification at page 23, lines 7-12 recites that the first rake combining device, for instance 26, is configured to provide a "control field" store data **necessary for decoding** in other words, the first rake combiner is necessary in order to generate the "control field". In addition, the specification further teaches that a "second rake combining device" for providing the "data field". Both the "data field" and the "control filed" generated by the first and second "rake combiners" are necessary for decoding by the decoder. There is no embodiment in the specification however where a **single rake combiner** is coupled to the memory

Art Unit: 2611

and the decoder. The claims require a pair of combiners to be connected to a respective memory device.

4. Claims 6 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 6, lines 13-14, recite "based on the service type of the received signals", however such limitation does not have support in the specification as claimed. The specification at page 23, lines 12-15, the decoding unit reads out data having a high priority successively from the memories "according to priority notified from the reception processing control circuit". The same comment applies to claim 14.

Claim Objections

5. Claims 6 and 14 are objected to because of the following informalities: as per claim 6, the claim language "via a memory" (line 6) and "a plurality of memories" (line 7) suggests that the decoder is coupled to a "memory" and also to a respective one of "a plurality of memories" while in fact the decoder according to the specification, as filed, see fig. 8, is coupled to "respective one of the plurality of memories". It is suggested that the claim be amended to in such a way as to be consistent with the specification, as filed. Claim 6, line 7, "respective" should be inserted before rake. As per line 14,

Art Unit: 2611

"received signals having a **high priority**" with respect to what? Similar comment applies equally to similar limitations recited in claim 14. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The prior art rejection has been withdrawn in view of the claimed amendment, filed on 7/3/06.

Response to Arguments

7. Applicant's arguments filed 7/3/06 have been fully considered but they are not persuasive. It is alleged that two rake combiners are not essential to the invention. Examiner disagrees. As stated above, the specification does not include an embodiment where a memory is connected between a single "rake combiner and a decoder. The specification page 23, lines 7-15 and fig. 8, clearly teach that "the control field" generated by the "first rake combiner" is essential for decoding" in addition the specification teaches a second rake combiner to generate "data field". Both the data field and the control field are required for decoding. Hence, it is essential for the first and second rake combiners are provided so that the control field and the data field required for decoding are generated.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2611

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean B. Corrielus whose telephone number is 571-272-3020. The examiner can normally be reached on Maxi-Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel can be reached on 571-272-2988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JEAN B. CORRIELUS
PRIMARY EXAMINER

8-17-06